

REMARKS

Reconsideration of the present application in view of the following remarks is respectfully requested. The application includes claims 2, 3 and 73-109, pending and under consideration, and claims 110-116 have been withdrawn from consideration.

In the outstanding Action, the Examiner reinstituted multiple claim rejections that had previously been withdrawn in view of the Applicants' showing of entitlement to an effective filing date preceding the effective date of the cited McKay reference. The Examiner has now asserted at page 2 of the outstanding Action that, "applicant is in error concerning establishment of the date to application 08/740,031. It appears that the current application was filed after the abandonment date of the earlier filed application." As a result, the Examiner has reinstated the previous rejections asserted in the prior Office Action dated April 5, 2005.

In traversal, Applicants submit that a careful review of the claim of priority in the present case to the prior-filed case (Application No. 10/114, 675) has not revealed any error as asserted in the Action. Specifically, the present application was filed on February 18, 2004, using the prescribed Express Mail filing procedure. The Official Filing Receipt mailed by the U.S. Patent and Trademark Office on May 14, 2004, reflects February 18, 2004, as the filing date for the application. The prior-filed case to which this application claims priority (Application No. 10/114, 675) was pending through and including February 18, 2004. Indeed, an Office Action in that case was mailed by the U.S. Patent and Trademark Office on

November 18, 2003, and provided a three-month period for reply (i.e., extending to and including February 18, 2004). As such, Applicants respectfully submit that the Applicant's establishment of priority to Application No. 08/740,031 is proper, that the reinstatement of the prior rejections is improper, and that the rejections must again be withdrawn.

In addition to the above, the outstanding Office Action re-asserts the same claim rejections that were asserted in the Office Action dated February 28, 2006, but makes no acknowledgement of or reference to the amendments and arguments presented by Applicants in the response dated June 27, 2006. For this reasons, it is believed that the prior amendments and arguments may have been overlooked. Applicants therefore present the arguments again below for the convenience of the Examiner. Because the claim amendments were previously submitted for entry, the claim amendments are not presented again herein, but rather the claims are set forth above in their previously-amended form.

Reiteration of prior arguments:

Applicants again acknowledge and thank the Examiner for the indication in the outstanding Action that claims 83 and 84 recite allowable subject matter. The Action states that these claims are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. For the reasons stated herein, Applicants submit that the base claim and the intervening claims are also in condition for allowance, and that this objection to claims 83 and 84 is therefore moot. Withdrawal of this objection is therefore respectfully requested.

Claims 2, 3, and 73-82, 85-92 and 94-106 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Grivas et al. (5,814,084) in view of Heggeness, et al. (5,514,180) and either of O’Leary et al. (5,290,558) or Prewett et al. (5,314,476). Applicants traverse this rejection and submits that the claims are patentable over the cited combination of references.

Independent claim 73 has been amended to specify that the spinal spacer comprising a cylindrical bone dowel has an osteogenic composition impregnated therein. It is worthy of note that no suggestion has been made in the outstanding Action that the cited combination of references calls into question the patentability of current claim 73, as amended. Applicants submit that none of the cited references, either alone or in combination with one another, suggests or contains any teaching that might lead a person of ordinary skill in the art to impregnate a bone dowel with an osteogenic composition including a substantially pure osteogenic factor as recited in pending claim 73, as amended. The primary reference cited in the outstanding Office Action, the Grivas patent, is relied upon in the outstanding Action as disclosing “a spinal spacer for insertion into a disc [sic] space between adjacent vertebrae including a cylindrical bone dowel having a chamber filled with osteogenic material that services to promote rapid fusion of the vertebrae.” The Grivas patent, however, is devoid of any teaching or suggestion of impregnating an osteogenic composition into a bone dowel, as recited in claim 73 of the present application, as amended. Indeed, the desirability of the claimed invention is taught only by the present application.

The secondary reference, Heggeness et al., is relied upon in the outstanding Action as disclosing “the use of [BMP] proteins to foster and induce new tissue formation to promote fusion between the vertebrae and the spinal spacer.” Heggeness et al., however, likewise is devoid of any teaching or suggestion of impregnating an osteogenic composition into a bone dowel, as recited in claim 73 of the present application, as amended. In addition, neither Grivas et al. nor Heggeness et al. discloses or suggests the use of a substantially pure osteogenic factor in a spinal spacer, as recited in claim 73. In view of the above, Applicants submit that claim 73, as amended, is in condition for allowance, and respectfully requests withdrawal of the rejection thereof that is asserted in the outstanding Office Action.

Claims 2, 3, 74-75 and 77-93 depend, either directly or indirectly, from independent claim 73. Applicants submit that these dependent claims recite patentable subject matter for at least the same reasons that the subject matter of independent claim 73 is patentable, and for other reasons. While dependent claim 92 is rejected in the outstanding Action over a different combination of references, including the above-cited references and an additional reference (Brekke), Applicants submit that this combination also fails to teach or suggest the invention recited in claim 92 for the same reasons that the cited references fail to teach or suggest the invention recited in independent claim 73, as amended. Brekke has the same deficiencies as Grivas et al. and Heggeness et al., and does not provide any teaching or suggestion of the claimed invention.

Applicants submit that independent claim 94, as amended, is also in condition for allowance. The invention recited in claim 94, as amended, is patentable over the cited

references at least because this claim recites an element that is not disclosed or suggested in any of the references or record, namely, a “substantially pure osteogenic factor.” None of the cited references teaches or suggests the use of a “substantially pure osteogenic factor” in any manner, much less in connection with in a dowel comprising bone graft, as recited in claim 94. It is axiomatic that an asserted combination of reference fails to support a rejection of a patent claim under Section 103 of the Patent Statute where the claim recites an element or feature that is absent from the cited references. In other words, in order for an asserted combination to be proper, not only must the references themselves or other prior art contain a suggestion that would motivate a person of ordinary skill in the art to combine the teachings of the references, but in addition, once they are combined, the combination must include all elements of the claimed invention. Applicants submit that the references of record fail to support a rejection of claim 94 in the present case because none of the cited references, even if properly combined, teaches or suggests the use of a “substantially pure osteogenic factor.” Applicants therefore submit that the asserted rejection of claim 94 must be withdrawn. In view of the above, Applicants submit that claim 94, as amended, is in condition for allowance, and respectfully requests withdrawal of the rejection of claim 94 that is asserted in the outstanding Office Action.

Claims 95-115 depend, either directly or indirectly, from independent claim 94. Applicants submit that these dependent claims recite patentable subject matter for at least the same reasons that the subject matter recited in independent claim 94 is patentable, and for other reasons. While dependent claims 107-109 are rejected in the outstanding Action over a

different combination of references including the above-cited references and an additional reference (Bianchi), Applicants submit that this combination also fails to teach or suggest the invention recited in claims 107-109 for the same reasons that the cited references fail to teach or suggest the invention recited in independent claim 94, as amended.

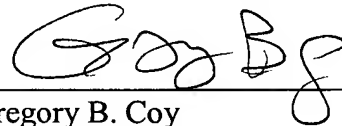
In view of the foregoing remarks, Applicants respectfully submit that none of the rejections asserted in the Action can properly be maintained. Accordingly, reconsideration leading to withdraw of all the rejections under 35 U.S.C. § 103(a) and allowance of this application containing claims 2, 3 and 73-109 are respectfully requested.

Closing

In view of the above, Applicants respectfully submit that the rejections stated in the outstanding Action are overcome and that the present application is in condition for allowance. Action to that end is respectfully requested. If there are any remaining issues that can be addressed telephonically, the Examiner is invited to contact the undersigned to discuss the same. Nothing in this document is intended to be an admission that any of the cited references qualifies as prior art. Rather, Applicants expressly reserve the right to make showings at a later time to remove/disqualify one or more references from the prior art, if appropriate.

Respectfully submitted,

By: _____



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